

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No.: 10/031,064

Atty Docket No.: Q68069

AMENDMENTS TO THE DRAWINGS

Applicant submits a Replacement Sheet for the Drawings wherein reference numeral 7 is now shown in Fig. 1.

Attachment: Replacement Sheet

REMARKS

Applicant submits the present amendment in response to the non-final Office Action dated December 17, 2004, in which the Examiner objected to the Drawings and rejected claims 1-11. A Replacement Sheet for the Drawings has been submitted. Claims 3 and 7 have been amended. New claim 12 has been added. Favorable reconsideration is requested in view of the above amendments and the following remarks.

The Drawings have been objected to due to the absence of a “reference numeral 7.” An attached Replacement Sheet showing reference numeral 7 in Fig. 3 has been submitted.

Claim 3 has been rejected under 35 U.S.C. §112, 2nd paragraph due to the lack of antecedent basis with respect to “the welding.” Claim 3 has been amended to provide sufficient antecedent basis.

Claim 4 has been rejected under 35 U.S.C. §112, 2nd paragraph because the language “next-but-one” is allegedly unclear. Applicant submits that one of ordinary skill would understand the meaning of “next-but-one” in view of the present disclosure (see page 9, lines 27-27 through page 10, lines 1-7).

Claim 7 has been rejected under 35 U.S.C. §112, 2nd paragraph because the language “preferably” is allegedly unclear. The language “preferably less than 2.5” has been deleted from claim 7 and new claim 12 has been added to recite the preferred range represented by “less than 2.5.”

Claims 1-4 and 6-10 have been rejected under 35 U.S.C. §102(a) as anticipated by or, in the alternative, rendered obvious under 35 U.S.C. §103(a) over “Applicant's Disclosure.”

Claim 5 has been rejected under 35 U.S.C. §103(a) over “Applicant's Disclosure.”

Claim 11 has been rejected under 35 U.S.C. § 103(a) over “Applicant’s Disclosure” in view of Wallsten et al (U.S. Pat. No. 5, 061, 275) (also cited in “Applicant’s Disclosure”).

As an initial matter, “Applicant’s Disclosure” cannot be used as a reference against the Applicant. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on “Applicants’ disclosure” (*see*, MPEP § 2143 and *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Additionally, Applicant respectfully submits that the information contained in the specification fails to teach or render obvious any of the claims of the present application at least by virtue of the absence of the join limitation of claim 1 and claims 2-11 which depend therefrom.

The present claimed invention relates to a radially self-expanding stent for implantation in a body passage comprises first and second sets of mutually counter-rotating metallic filaments which are braided together and define a tubular stent body having two ends which is mechanically biased towards a first radially expanded configuration in which it is unconstrained by externally applied forces and can be retained in a second radially compressed configuration. Some or all of the filament ends at the ends of the body are fixed together in pairs each consisting of counter-rotating filaments by placing the filaments over one another and placing them adjacent to and substantially parallel to one another and further comprising a join at each end fixing to retain the ends of the filaments in contact with one another.

The Examiner relies upon the join arrangement shown on the right side of Figure 3 and described at the top of the table shown in Figure 4 to assert that because the filament ends are

fixed together by placing the filaments over one another and placing them adjacent to and substantially parallel to one another, Applicant's claimed invention is anticipated or rendered obvious.

The join arrangement claimed by Applicant is distinguishable from the "join arrangement" shown in Figure 3 and relied upon by Examiner. More specifically, the join arrangement claimed by Applicant comprises some or all of the filament ends at the ends of the body fixed together in pairs each consisting of counter-rotating filaments by placing the filaments over one another and placing them adjacent to and substantially parallel to one another and further comprising a join at each end fixing to retain the ends of the filaments in contact with one another. The prior art joins by a simple twisting arrangement.

Applicant's position is supported by the data shown in Figure 4 which evidences the surprising and particular benefits conferred by Applicant's join configuration as compared to the prior art.

Further, as stated in the present disclosure, though Wallsten et al earlier suggested in WO 83/-3572, that filaments may be joined in order to prevent unraveling and splaying outward of ends before or after stent deployment, Wallsten et al in U.S. Pat. No. 5, 061, 275 later taught away from welding filament pairs (see e.g. col. 3, lines 13-23) stating that welding reduces the elasticity of a prosthesis and also results in further accentuation of risk of the wall of the vessel.

In view of the foregoing remarks, claim 1 is not anticipated or rendered obvious in view "Applicant's disclosure" or in view "Applicant's Disclosure." Applicant respectfully submits that dependent claims 2-11 are patentable at least by virtue of their dependency from claim 1

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

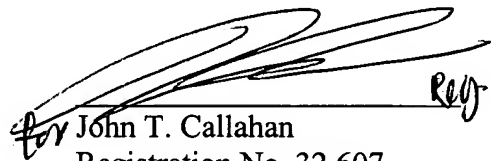
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